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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,696	06/26/2000	Philip Carragher	Carr-P1-00	4961

28710 7590 10/18/2006

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EXAMINER


KARMIS, STEFANOS

ART UNIT PAPER NUMBER

3691

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/604,696	Applicant(s) CARRAGHER ET AL.	
	Examiner Stefano Karmis 	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's arguments filed 24 July 2006.

Status of Claims

2. There are no current amendments to the claims. Claims 1-49 are currently pending.

Response to Arguments

3. Applicant's arguments filed 24 July 2006 have been fully considered but they are not persuasive as discussed below. Therefore claims 1-49 stand rejected and Applicant's request for allowance is respectfully declined.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4, 5, 9, 10, 12, 13, 17, 19, 24, 28, 29, 32, 33, 35, 36, 40, 41, 43, 44 and 47-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342.

Claims 1, 28, 32 and 47-49 were previously rejected under 35 U.S.C. 102(e) as being anticipated by Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 as discussed in the previous office action, mailed 20 April 2006. Applicant contends that Hillman fails to disclose *determining a reward by calculating a function responsive to the card activity*. The Examiner respectfully disagrees. Hillman discloses a system for proving for investments to be made on behalf of an individual by a financial institution based on the individual's overall relationship to the financial institution (Abstract). The system rewards customers for their current relationship with a financial institution and encourages them to expand the relationship into other services offered by the financial institution and its affiliates (page 1, paragraph 0009). Hillman specifically discloses that the system provides a customer with a reward that is distributed to a customer program account (page 1, paragraph 0010). The reward funding is based on contribution formulas that track and reflect the use of accounts such as credit card accounts (page 2, paragraph 0014). Therefore Hillman discloses *determining/crediting a reward by calculating a function responsive to the card activity* and Applicant's remarks are not persuasive. Therefore claims 1, 28, 32 and 47-49 stand rejected. Claims 2, 4, 5, 9, 10, 12, 13, 17, 19, 24, 29, 33, 35, 36, 40, 41, 43, 44 are dependent upon claims 1, 28, 32, 47-49 and remain rejected as stated in the previous office action mailed 20 April 2006.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 3, 6, 25-27, 30, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 in view of Pettit U.S. Patent 4,722,554.

Claims 25-27, 30, 34 and 37 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 in view of Pettit U.S. Patent 4,722,554. Applicant provides substantially similar arguments for claims 25-27, 30, 34 and 37 as discussed above in the 35 USC § 102 rejection. Therefore the reasoning applied to show that Hillman does disclose *determining/crediting a reward by calculating a function responsive to the card activity* as stated for claims 1, 28, 32 and 47-49 applies here to claims 25-27, 30, 34 and 37. Therefore claims 25-27, 30, 34 and 37 stand rejected and Applicant's arguments are not persuasive. Claims 3 and 6 are dependent upon claims 1, 28, 32, 47-49 and remain rejected as stated in the previous office action mailed 20 April 2006.

10. Claims 7, 8, 11, 14, 18, 38, 39, 42, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 in view of Atkins U.S. Patent 5,644,727.

Claims 7, 8, 11, 14, 18, 38, 39, 42, 45 and 46 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 in view of Atkins U.S. Patent 5,644,727. Applicant provides substantially similar arguments for claims 7, 8, 11, 14, 18, 38, 39, 42, 45 and 46 as discussed above in the 35 USC § 102 rejection. Therefore the reasoning applied to show that Hillman does disclose *determining/crediting a reward by calculating a function responsive to the card activity* as stated for claims 1, 28, 32 and 47-49 applies here to claims 7, 8, 11, 14, 18, 38, 39, 42, 45 and 46. Therefore claims 7, 8, 11, 14, 18, 38, 39, 42, 45 and 46 stand rejected and Applicant's arguments are not persuasive.

11. Claims 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 in view of Ogilvie U.S. Patent 6,631,358.

Claims 16 and 23 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 in view of Ogilvie U.S. Patent 6,631,358. Applicant provides substantially similar arguments for claims 16 and 23 as

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discussed above in the *35 USC § 102* rejection. Therefore the reasoning applied to show that Hillman does disclose *determining/crediting a reward by calculating a function responsive to the card activity* as stated for claims 1, 28, 32 and 47-49 applies here to claims 16 and 23. Therefore claims 16 and 23 stand rejected and Applicant's arguments are not persuasive.

12. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342.

Claims 20-22 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman). Applicant provides substantially similar arguments for claims 20-22 as discussed above in the *35 USC § 102* rejection. Therefore the reasoning applied to show that Hillman does disclose *determining/crediting a reward by calculating a function responsive to the card activity* as stated for claims 1, 28, 32 and 47-49 applies here to claims 20-22. Therefore claims 20-22 stand rejected and Applicant's arguments are not persuasive.

13. Claim 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 in view of Sullivan U.S. Patent 6,941,279.

Claim 31 was previously rejected under 35 U.S.C. 103(a) as being unpatentable over Hillman et al. (hereinafter Hillman) U.S. Publication 2003/0093342 in view of Sullivan U.S. Patent 6,941,279. Applicant provides substantially similar arguments for claim 31 as discussed above in the *35 USC § 102* rejection. Therefore the reasoning applied to show that Hillman does

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disclose *determining/crediting a reward by calculating a function responsive to the card activity* as stated for claims 1, 28, 32 and 47-49 applies here to claim 31. Therefore claims 31 stand rejected and Applicant's arguments are not persuasive.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

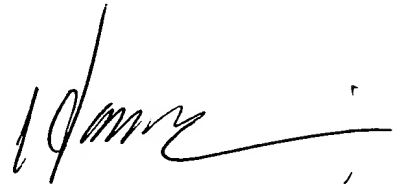
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
Stefano Karmis
13 October 2006



HANI M. KAZIMI
PRIMARY EXAMINER